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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOHRU TACHIBANA and
YUHICHI TAKAHASHI

Appeal 2009-004217
Application 10/674,180
Technology Center 2100

Decided: February 24, 2010

Before LANCE LEONARD BARRY, JOHN A. JEFFERY, and JAMES R.
HUGHES, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1 and 3-14. We have jurisdiction under 35 U.S.C. § 6(b) (2008). We reverse.

STATEMENT OF THE CASE

Appellants invented an information terminal, system, method, and product for processing information into an information terminal 30 (e.g., a cellular phone) that has a screen too small to display all the information from the server 20. This arrangement also assists a server 20 in processing input information transmitted from the information terminal 30 expeditiously. *See generally* Spec. ¶¶ {001}, {004}, and {012}-{014}; FIG. 1.

Claim 1 is reproduced below:

1. An information terminal which displays input pages downloaded from a server via a network, and which transmits, using the network, information entered into the input pages by a user, said information terminal comprising:

a page display section for displaying a plurality of input pages using a browser executed by the information terminal;

an input information storage section for storing a plurality of input parameters entered by a user into more than one of the input pages;

an input information transmission section for transmitting the plurality of input parameters in response to an instruction; and

a page reception section for receiving the input pages and for associating the input pages with package identification information, wherein the input pages enable a user to enter the plurality of input parameters, and further wherein the input information transmission section combines the input parameters

entered into the input pages of a package and transmits the combined input parameters to the server.

The Examiner relies on the following as evidence of unpatentability:

Iida US 2002/0032739 A1 Mar. 14, 2002

THE REJECTION

The Examiner rejected claims 1 and 3-14 under 35 U.S.C. § 102(e)¹ as anticipated by Iida. Ans. 3-8.²

The Examiner finds that Iida discloses all the elements of the information terminal recited in claim 1, including “an input information storage section for storing a plurality of input parameters entered by a user into more than one of the input pages.” *Id.* at 3. In particular, the Examiner finds memory 9 and storage means within servers 7 and 8 are the input information storage section. *Id.* at 3 and 9. The Examiner also states paragraphs thirty-one and thirty-two of Iida describe a graphical user interface shown in Figure 4 that accepts user inputs and stores the inputs in element 9. *Id.* at 9. The Examiner finds that the information terminal’s input information transmission section is the part of the portable device that communicates with the gateway server 7. *Id.* at 3 and 10.

Appellants argue Iida does not disclose the recited input information storage section. App. Br. 7-8. Appellants assert that Iida’s memory 9 stores text data received from gateway server 7—not input parameters entered by the user. *Id.*; Reply Br. 2. Additionally, Appellants contend that Iida does

¹ While rejected under paragraph (e), Iida also qualifies as prior art under paragraph (b) of § 102.

² Throughout this opinion, we refer to (1) the Appeal Brief filed November 30, 2007; (2) the Examiner’s Answer mailed February 5, 2008; and (3) the Reply Brief filed March 30, 2008.

not disclose an input information transmission section for combining and transmitting the input parameters. App. Br. 9-10; Reply Br. 3-5.

The issues before us, then, are as follows:

ISSUES

Under § 102, have Appellants shown that the Examiner erred in rejecting claim 1 by finding that Iida discloses:

- (1) an input information storage section for storing a plurality of input parameters entered by a user into more than one of the input pages; and
- (2) an input information transmission section for transmitting the combined input parameters to the server?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

Iida

1. Iida discloses a system that includes: (a) a portable terminal 1 having a display 2, memory 9, and input key 4; (b) the Internet 5; (c) a gateway server 7; and (d) a Post Office Protocol (POP) server. This system transmits to, and receives text data from, a portable terminal 1 using a browser installed on the terminal. ¶¶ [0002] and [0031]-[33]; FIGs. 1-2.
2. Iida discloses that memory 9 stores message data (e.g., email messages) received from the Internet 5. For example, a user requests an email from a list at step S1, and the POP server outputs the main text data of the email to gateway server 7. The server 7 at step S2 determines how to divide the e-mail's main text data based on the storage capacity of the screen

display's memory 9, and outputs the first page to the portable terminal at S3. When the next page is requested at S4, the server 7 sends the next page to the portable terminal 1 at S5. ¶¶ [0031], [0032], and [0034]-[38]; FIGs. 3-4.

3. Figure 4(a) of Iida shows the first page of an email message on the portable terminal's display 2 includes a character (e.g., an icon) of "NEXT PAGE." Figure 4(b) shows the next page includes "NEXT PAGE" and "PREVIOUS PAGE" characters. ¶¶ [0037], [0038], [0040]-[41]; FIGs. 4(a)-(b).

4. Iida transmits messages from portable terminal 1 to gateway server 7 and POP server 8. Figure 6(a) shows an empty text input box for the user to write a message that includes characters (e.g., icons) "SEND" to send the message or "CONTINUE TO WRITE MAIN TEXT" to continue to write the message. Figures 6(b)-(c) show multiple text input boxes and also includes the "SEND" and "CONTINUE TO WRITE MAIN TEXT" characters. ¶¶ [0043]-[48]; FIGs. 5-6.

PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

"If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir.

1999). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (quotation marks and citation omitted).

ANALYSIS

We are constrained, based on the record before us, to find error in the Examiner’s anticipation rejection of claim 1. At the outset, we agree with the Examiner that the recitation “for storing a plurality of input parameters entered by a user into more than one of the input pages” in claim 1 is a functional limitation. *See* Ans. 9. Nonetheless, Iida must disclose elements capable of performing this function. *See RCA Corp.*, 730 F.2d at 1444. Claim 1 also recites more than the functional limitation of an input information transmission section for transmitting the input parameters. Claim 1 positively recites that the transmission section combines the input parameters and transmits the combined parameters to the server. With this understanding in mind, we turn to Iida.

The Examiner relies on Iida’s memory 9 and the storage in servers 7 and 8 to meet the claimed limitation of an input information storage section for storing a plurality of input parameters entered by a user into more than one of the input pages. Ans. 3 and 9. As Appellants correctly indicate (App. Br. 8), Iida states that information (i.e., part of an email message shown in the screen of Figure 4(a)) stored in memory 9 at step S3 is from the gateway server 7. *See* FF 2-3. Appellants argue that this disclosure therefore fails to disclose that memory 9 is used for storing input parameters entered by a user. App. Br. 8. Arguably, since the “user” has not been defined in claim

1, this email message contains text or input parameters entered by a user (e.g., another information terminal's user) into more than one of the input pages (e.g., screens in Figs 4(a) and (b)). Furthermore, the text or input parameters are stored in memory 9 (i.e., an "input information storage section" of an input terminal 1). FF 2. However, Iida discloses storing only one page or screen at a time (e.g., screens shown in Figures 4(a)-(c)) based on the screen display's memory (*see* FF 2-3) and, thus, does not disclose that the storage section 9 is capable of storing input parameters entered by a user into more than one input page. Iida also fails to disclose an input information transmission section that combines and transmits the combined input parameters (i.e., text of the received email) to the server as required by claim 1. *See* FF 4.

Figure 4(b) shows a portable terminal's display 2 having an input page with two input parameter (e.g., NEXT PAGE or PREVIOUS PAGE selection). FF 3. The selection of NEXT PAGE or PREVIOUS PAGE (e.g., an input parameter) by a user of the information terminal 1 must be stored somewhere in the portable terminal 1 so that this information is transmitted back to the server. *See* FF 1-2. That is, the input will necessarily be stored on the portable terminal at least temporarily. Nonetheless, Iida fails to disclose where this input parameter selection is stored or that more than one input parameter is stored. *See* FF 3. Even if it is *probable* that the input parameter is stored in memory 9, such possibilities are insufficient to show anticipation. *See Robertson*, 169 F.3d at 745. Iida also fails to disclose that the selected information is stored into more than one of the input pages as claim 1 requires. *See* FF 3.

Figures 6(a)-(c) shows another example in Iida where a user can input text and select other input parameters (e.g., to SEND or CONTINUE TO WRITE MAIN TEXT) within a browser of an information terminal 1 or an input page. FF 1 and 4. While the text and selections are possibly stored within memory 9, Iida is silent on this point and does not disclose storing the parameters entered by a user into more than one of the input pages. *See* FF 2-4. Moreover, Iida does not disclose that these input pages are downloaded from a server as required by claim 1. *See* FF 4. Thus, this embodiment in Iida is also insufficient to show anticipation.

Lastly, servers 7 and 8 are not part of the information terminal 1 (FF 1) and, thus, cannot be an information terminal's input information storage section. We are therefore constrained to find that Iida does not disclose an information terminal having an input information storage section for storing a plurality of input parameters entered by a user into more than one of the input pages and an input transmission section that combines the input parameter entered by the user and transmits the combined input parameters to the server as required by claim 1.

Independent claims 10-14 have limitations similar to the limitation "an input information storage section for storing a plurality of input parameters entered by a user into more than one of the input pages . . . wherein the input information transmission section transmits the combined input parameters to the server" found in claim 1. Additionally, dependent claims 3-9 depend from claim 1 and include the above limitations found in claim 1. We are therefore persuaded by Appellants' arguments (Br. 7-12 and 20-23) for the reasons discussed above in connection with claim 1 and Iida.

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For the foregoing reasons, Appellants have shown error in the anticipation rejection of independent claim 1 based on Iida. We will not sustain the rejection of independent claims 1 and 10-14 and dependent claims 3-9.

CONCLUSION

Appellants have shown that the Examiner erred in rejecting claims 1 and 3-14 under § 102.

ORDER

The Examiner's decision rejecting claims 1 and 3-14 is reversed.

REVERSED

nhl

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